Please find below and/or attached an Office communication concerning this application or proceeding.

MAILED

JUN 0 2 2005

Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/740,528
Filing Date: December 18, 2000
Appellant(s): DUTTA, RABINDRANATH

_____

<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 April 2005.

1. *Real Party in Interest*

A statement identifying the real party in interest is contained within the brief.

2. *Related Appeals and Interferences*

A statement indicating Applicant is unaware of any related appeals or interferences is contained within the brief.

3. *Status of Claims*

The statement of the status of the claims contained within the brief is correct.

4. *Statement of Amendments After Final*

The Appellant's statement of the status of amendments after final rejection contained within the brief is correct.

5. *Summary of Invention*

The summary of the invention contained within the brief is correct.

6. *Issues – Grounds of Rejection to Be Reviewed on Appeal*

The Appellant's statement of the issues within the brief is correct.

7. *Grouping of Claims*

The rejection of Claims 1-3, 5-14 & 16-21 stand or fall together because

Appellant's brief does not include a statement that this grouping of claims does not

stand or fall together and reasons in support thereof. See CFR 1.192(c)(7).

8.   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

9.   *Prior Art of Record*

Examiner relied upon the following prior art in the rejection of the claims under

appeal:

> US 6,288,753 B1   DeNicola   07-1999

10.   *Grounds of Rejection*

1.   The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-14 & 16-21 are rejected under 35 U.S.C. § 103(a).

The above-noted rejections are set forth in a prior Office Action, mailed on 10

November 2004. The prior Office Action is included herein below:

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-3, 5-14 & 16-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over further consideration of US Patent US 6,288,753 B1 to DeNicola.

4.   Regarding Newly Amended Claims 1, 8 & 14 and Original Claims 6, 12 & 18,

DeNicola discloses a method, system and computer program product for administering

exam content from a server to at least one client over a network, (Abstract; Col. 3, lines

31-33; Col. 4, lines 51-67; and Col. 5, lines 1-7), comprising:

- registering at least one (or a plurality – per pending Claims 6, 12 and 18)

    exam(s) submitted by an exam provider with the server, (Col. 4, lines 51-

    67; Col. 5, lines 1-7 and 49-67; Col. 6, lines 1-21 and Col. 11, lines 65-67);

- transmitting a video frame of a student to the server at least during the

    exam, (per Newly Amended Claims 1, 8 & 14), (Abstract; Col. 4, lines 21-

    67; Col. 5, lines 1-7; Col. 7, lines 15-30; and Col. 17, lines 27-67);

- generating a transcript in response to answers submitted by a student to

    at least one exam question resident on the server, (Col. 13, lines 37-64);

    and

- providing access to the transcript to at least one third party, (Col. 13, lines

    65-67; Col. 14, lines 1-67; and Col. 15, lines 1-57).

5.   As noted herein, DeNicola discloses transmission of a video frame of a student to

the server during the exam. DeNicola does not specifically enumerate that such

transmission is for directed use of student verification, however, to use the video for

student verification purposes would have been obvious to one of ordinary skill in the art

at the time of invention by Applicant. The motivation to combine exits within DeNicola

which teaches test taking, (Abstract), and report creation, (Col. 15, lines 34-45),

providing on-line learning reinforcement regarding on-line learning/training courses and

testing to an end user coupled to the Internet via WebPages, (Col. 6, lines 6-21). As

DeNicola further provides for third-party viewing of test information for

teaching/evaluation purposes, association of student work, with a visual depiction of the

student would have aided in the same. Thus, it would have been obvious for a student

report, (or transcript) to contain a visual depiction of the student for verification

purposes, especially considering the fact that DeNicola provides for said visual

depiction as well as student reports. Examiner further notes that nowhere in the original

claims does Applicant enumerate the specific directed use of visual depiction for student

verification. Thus, Newly Amended Claims 1, 8 & 14 and Original Claims 6, 12 & 18 are

found to be unpatentable over considerable consideration of DeNicola.

6.   Regarding Claims 2, 10 & 16, DeNicola discloses a method, system and

computer program product for administering exam content further comprising providing

an exam content generator with access to registered exams on the server, (Col. 11,

lines 48-67; Col. 12, lines 1-67 and Col. 13, lines 1-47). Thus, Claims 2, 10 & 16 are

found to be unpatentable over considerable consideration of DeNicola.

7.   Regarding Claims 3, 9 and 17, DeNicola discloses a method, system and

computer program product for administering exam content further comprising providing

an exam grader with access to student's answers on the server, (Col. 13, lines 37-64

and Col. 17, lines 44-60). Thus, Claims 3, 9 and 17 are found to be unpatentable over

considerable consideration of DeNicola.

8.   Regarding Newly Added Claims 20 & 21 and Original Claim 11, DeNicola

discloses a method, system and computer program product for administering exam

content further comprising transmitting a video frame of the student to the server at at

least one random point in time while the student is taking the exam, (per pending

Claims 4 & 15), wherein the server comprises a means for accepting, (recording) and

storing video images of the student, (per pending Claim 11), (Abstract; Col. 4, lines 21-

67; Col. 5, lines 1-7; Col. 7, lines 15-30; and Col. 17, lines 27-67). As noted above,

Examiner reiterates that as DeNicola further provides for third-party viewing of test

information for teaching/evaluation purposes, association of student work with a visual

depiction of the student would have aided in the same. Thus, it would have been

obvious for a student report, (or transcript) to contain a visual depiction of the student

for verification purposes, especially considering the fact that DeNicola provides for said

visual depiction as well as student reports. Thus, Newly Added Claims 20 & 21 and

Original Claim 11 are found to be unpatentable over considerable consideration of

DeNicola.

9.   Regarding Claim 5, DeNicola discloses a method, system and computer program

product for administering exam content wherein the transcript further comprises at least

one video image of the student, (Abstract; Col. 4, lines 21-67; Col. 5, lines 1-7; Col. 7,

lines 15-30 and 61-64; Col. 15, lines 27-45; and Col. 17, lines 9-67). As noted above,

Examiner reiterrates that as DeNicola further provides for third-party viewing of test

information for teaching/evaluation purposes, association of student work with a visual

depiction of the student would have aided in the same. Thus, it would have been

obvious for a student report, (or transcript) to contain a visual depiction of the student

for verification purposes, especially considering the fact that DeNicola provides for said

visual depiction as well as student reports. Thus, Claim 5 is found to be unpatentable

over considerable consideration of DeNicola.

10.   Regarding Claims 7, 13 and 19, DeNicola discloses a method, system and

computer program product for administering exam content further comprising recording

a student's answers to at least one exam question presented by the server; and grading

the student's answers to generate an exam result, (Col. 13, lines 37-64). Thus, Claims

7, 13 and 19 are found to be unpatentable over considerable consideration of DeNicola.

11.   ***Response to Arguments***

11.1   DeNicola '753 in fact discloses the visual transmission of a visual image of
        a student in conjunction with a test, (Appeal Brief: p.9)

Appellant argues that DeNicola '753 does not disclose storage and correlation of

a student image with a transcript for a specific test for verification purposes, (Appeal

Brief: p.4). Examiner respectfully disagrees noting the same would have been obvious

as enumerated herein above.

Specifically, Examiner finds that the DeNicola '752 patent clearly teaches a

system and method for interactive distance learning wherein teachers are able to

monitor and test students over a network from a remote location through the use of

video, (Abstract & Col 9, lines 9-14). DeNicola further comprises a student database for

storage of all student information, (Figs. 10A & 10B), which database is associated with

the testing database as needed, (Col. 5, lines 49-61). Moreover, the video of the

students is simultaneously archived, (Col. 7, lines 61-66), wherein archiving of the video would obviously mean "organized storage" of the same.

Additionally, De Nicola clearly teaches the ability to give an examination to a student during a lecture through the use of collaboration software, (Col. 9, lines 60-67 & Col. 11, lines 42-52).

The numerous databases within DeNicola may be centralized or distributed, (Col. 12, lines 26-37), and are open database compliant meaning that a file generated can be used by any conventional database, (Col. 15, lines 14-33). Additionally, the client/test administrator may specify what data is displayed, (i.e.: specific student data), (Col. 15, lines 14-33). Finally, DeNicola teaches real-time database cross-referencing of all submissions to the system, (Col. 13, lines 37-62), and quality control for tracking of student performance and other test-related data to oversee and maintain high quality testing, evaluation and reporting performance, (Col. 14, lines 39-62).

That noted, Examiner maintains that storage and correlation of a student (video) image with a transcript for a specific test for verification purposes would have been obvious when considered in light of the teachings of DeNicola. Specifically, as DeNicola teaches numerous archived databases with the ability to share files, wherein an administrator may specify displayed data, it would have been obvious to choose archived video data of the examination day, (to verify the student taking the exam), along with other archived student and exam information, displaying the same simultaneously. This is particularly likely in light of the quality control means also taught by DeNicola. Thus, though each type of information may be stored in a separate

database, the ability to cross-reference the databases clearly teaches correlation of the

same.

Further, Examiner notes that video data obviously comprises image data, which

image data may obviously and easily be stored within it's own database as reference

points, (i.e.: "thumbnails" representing the lecture, test, etc.), which images would take

up far less memory than video in addition to being quicker to download when used for

quality control purposes, (as an individual maintaining quality control may not need to

view a lengthy video when several individual images could confirm student presence).

In response to Appellant's argument that the references fail to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., correlation of <u>a specific student's image from among images of groups of students</u>

for test validation) is not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into

the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, Examiner notes that DeNicola provides a means by which to perform this

correlation in real-time, as noted herein above.

> ### 11.2   <u>DeNicola '753 in fact renders Appellant's claims unpatentable as directed</u>
> <u>use is not a patentable distinction, (Appeal Brief: p.9)</u>

In response to Appellant's argument that DeNicola '753 does not disclose

storage of images within the transcript specifically for student verification, (Appeal Brief:

p.9), a recitation of the intended use of the claimed invention must result in a structural

difference between the claimed invention and the prior art in order to patentably

distinguish the claimed invention from the prior art. If the prior art structure is capable of

performing the intended use, then it meets the claim. In a claim drawn to a process of

making, the intended use must result in a manipulative difference as compared to the

prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*,

312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Examiner notes that in light of the cross-referencing database means and quality

control means, use of images for student verification would have been obvious.

Moreover, storage of images for "verification" is a directed use of the same. Examiner

notes that the fact that Applicant has recognized another advantage that would flow

naturally from following the suggestion of the prior art cannot be the basis for

patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*,

227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In other words, DeNicola clearly

teaches the storage of video data, regardless of how the stored video data is used.

Finally, Examiner is confused by Appellant's argument which states, "in order to

verify a student's, the cited art stored images within a transcript so that an image

captured during an online test can be compared with the transcript picture", (Appeal

Brief, p. 10). Examiner questions whether this is an admission by Appellant, noting the

prior art clearly reads on the storage of images within a transcript. Additionally,

Examiner finds that the claims make no mention of comparing a separate pre-stored

transcript picture to an image captured during an exam. The dependent claim language

enumerates the transcript comprising at least one video image of the student; however,

the claim language does not specify when that image is captured or stored relative to

the transcript., and as such ay be read to be the image captured during an exam.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Arrienne M. Lezak

Conferees

David A. Wiley, Jack Harvey,

William Vaughn, Bunjob Jaroenchonwanit
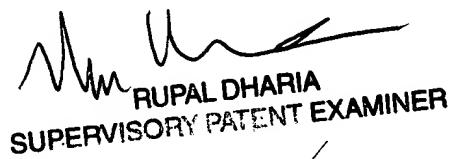
RUPAL DHARIA
SUPERVISORY PATENT EXAMINER
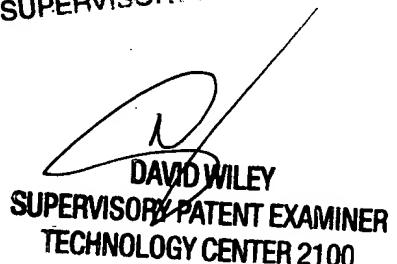
DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100